

REMARKS

Claims 10-15, 17, 20, 22-28, 30 and 32-33 are all of the pending claims, with claims 10, 15, 22 and 33 being written in independent form. By virtue of this amendment, Applicants (1) add new claim 33, and (2) cancel claims 16, 18, 19, 21, 29 and 31 without prejudice or disclaimer.

I. Claim Rejection Under 35 U.S.C. § 112 (1st):

The Examiner rejects claims 10-32 under 35 U.S.C. § 112 (1st) because claims 10, 15 and 22 recite the term “exchangeable,” which allegedly lacks adequate written description support in the specification. As a path of least resistance, and without acquiescing to the correctness of the Examiner’s position, Applicants amend independent claims 10, 15 and 22 by altogether deleting the objectionable term “exchangeable.”

II. Claim Rejection Under 35 U.S.C. § 112 (2nd):

The Examiner rejects claims 10-32 under 35 U.S.C. § 112 (2nd) because claims 10, 15 and 22 recite the term “exchangeable,” which is alleged to be unclear. As a path of least resistance and without acquiescing to the correctness of the Examiner’s position, Applicants amend independent claims 10, 15 and 22 by altogether deleting the objectionable term “exchangeable.”

III. Claim Rejections on Prior Art Grounds:

The Examiner rejects claims 10, 12-24 and 26-32 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,692,292 to Asai et al. (“Asai ‘292”); and claims 11 and 25 under 35 U.S.C. § 103(a) as being obvious over Asai ‘292 in view of U.S. Patent No. 5,588,195 to Asai et al. (“Asai ‘195”). Applicants respectfully traverse these rejections in view of the following remarks.

A. Independent Claims 10, 15, and 22:

As amended, independent claims 10, 15 and 22 recite (albeit in different formats) that each of the data storage devices **stores position data of said mounting member relative to a fixed reference mark**. Support for this feature may be found (for example) at page 3 (third full paragraph) of the instant specification. At least this feature (as claimed in claims 10, 15 and 22), in combination with the other features defined by claims 10, 15 and 22, is not taught or suggested by the prior art relied upon by the Examiner.

i) Applicants' Previous Arguments are Still Valid:

The Examiner continues to rely heavily upon Asai '292 to teach each and every feature of the invention defined by the independent claims of the instant application. Indeed, comparing the final rejection with the Examiner's previous Office Action, it appears that large portions are word-for-word identical to the rejections previously made. Applicants still believe that Asai '292 is not pertinent to the claimed invention for the reasons indicated in the previous response.

Specifically, Applicants acknowledge that each of Asai's working modules 12, 14, 16, 18 has a respective controller with a read-only memory (ROM) and a random-access memory (RAM). However, the ROMs and the RAMs are not comparable to the storage devices defined by the instant claims because the ROMs and the RAMs do **not** store position data of the working module relative to a fixed reference mark.

The disclosure of Asai '292 is straightforward and explicit regarding the type of data that may received by and/or stored by the controllers of the working modules. The pertinent portions of the disclosure indicate that the working devices of the working modules are controlled by the controllers on the basis of a **working schedule information**. This information may include data indicative of the kinds of electronic components, the number of electronic

components, the mounting positions on the circuit board, whether the components are provisionally fixed, and the number of circuit boards to be processed.¹ The disclosure also indicates that the controller of each working module may provide **status information**. This information may indicate whether an operation is complete, whether the supply of components has been exhausted, and whether the supply of a fixing material has been exhausted.² These rather extensive laundry lists of data (associated with the working schedule information and the status information) simply do **not** include any mention of data for the working module that is related to a fixed reference mark.

Further, at least with respect to claims 16-21 and 29-32, the Examiner cites portions of Asai '292 as allegedly teaching the storage of data that relate to a fixed reference mark. Applicants respectfully disagree at least because the cited portions refer to the data stored by the **common** processor, not the respective controllers of the working modules.³

For these reasons, Applicants respectfully submit that independent claims 10, 15, and 22 recite fundamental features (albeit functional ones) that are altogether missing from the Asai '292 reference.

ii) The Response to Arguments Section of the Office Action:

Not persuaded, the Examiner counters that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. For support, the Examiner attempts to look to the Federal Circuit decision of *In re Schreiber*.⁴ However, the Examiner's reliance upon *In re Schreiber* is misplaced since the case does **not** stand for the *per se* rule that

¹ Asai '292 (2:58-67).

² Asai '292 (3:1-10).

³ Asai '292 (5:54-63) and (23:24-45).

⁴ *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). A courtesy copy is enclosed for the Examiner's review.

an apparatus must be distinguished from the prior art in terms of structure rather than function.

In *In re Schreiber*, the claims at issue were directed to a top having a conical shape. *Schreiber* did not dispute that the structural limitations of the claims were found in the prior art.⁵ Instead, *Schreiber* argued (among other things) that the claims were patentable based on recitations directed to (1) intended use and (2) function. The Court was not persuaded and upheld the Board's decision. The Court's holdings with respect to intended use and function are discussed separately below.

The Holding Concerning Intended Use

Schreiber argued that that the claims at issue were patentable because the prior art failed to disclose the claimed intended use of dispensing popcorn from an open-ended popcorn container.⁶ The Court expressly agreed with *Schreiber's* characterization of the prior art, but nevertheless pointed out that “[i]t is well settled that the recitation of a new **intended use** for an old product does not make a claim to that old product patentable.”⁷ (emphasis added). This intended use rule is consistent with the helpful examination guidelines set forth in MPEP 2111.02.

In the situation at hand, the “store” feature of the claimed invention relates to the function (or operation) of the data storage devices, and not to the intended use of the automatic component mounting unit. That is, the “store” feature describes the operation of the data storage devices, while the preamble of the claims explicitly sets forth the intended use of “mounting an electrical component onto a substrate.” This mounting purpose is common to the device disclosed by Asai '292. In other words, Asai '292 discloses a device having the

⁵ *Id.* at 1431.

⁶ *Id.*

⁷ *Id.*

same intended purpose of mounting an electrical component onto a substrate. Certainly then, the “store” feature relates to function and not an intended use.

The Holding Concerning Function

Schreiber also argued that the claims at issue were patentable because they required functional limitations that were not present in the prior art. The Federal Circuit did **not** summarily discard these arguments as violating some *per se* rule that an apparatus must be distinguished from the prior art in terms of structure rather than function. In fact, just the opposite is true. The Court agreed with the conclusions of the Examiner and the Board that the functional features were ***inherently present*** in the prior art.⁸ (emphasis added). In this regard, the Court affirmed the well settled rule that functional limitations must be substantively considered. The Court even went on to explain that that a patent applicant is free to recite features of an apparatus either structurally ***or functionally***.⁹ (emphasis added).

The Court’s holding concerning function is consistent with the straightforward examination guidelines set forth in the MPEP. Indeed, MPEP 2173.05(g) indicates that a functional limitation is often used in association with an element to define a particular capability or purpose that is served by the recited element, and that such limitations must be evaluated and considered just like any other limitation of the claim. For these reasons, Applicants respectfully submit that the Examiner should substantively consider the functional features of the claimed invention.

In summary, the Court did in fact substantively consider the functional features of *Schreiber*’s claims, but it did not refuse to consider such features for being directed to function (as opposed to structure), as alleged by the Examiner.

⁸ *Schreiber* at 1432.

⁹ *Id.*

Turning to the next point, the Examiner reasons that the “fixed reference mark” can be the entire stationary footprint area of the unit shown in FIG. 1 of Asai ‘292. The Examiner therefore concludes that the working schedule information of Asai ‘292 is related to the footprint area of the unit, since the working modules operate within the footprint area of the unit. Even if the Examiner’s position were correct, Applicants respectfully submit that the working schedule information does not provide any information that can be properly characterized as position data of the working module, much less position data of the working module relative to a fixed reference mark.

Finally, the Examiner points out that the ROMs and the RAMs of the Asai ‘292 references are memory devices, and are therefore “capable” of storing the data defined by the pending claims. However, it is well settled that, for an anticipation rejection, a reference must teach each and every aspect of the claimed invention. Any feature not directly taught must be inherently present. As demonstrated above, Asai ‘292 merely indicates (albeit indirectly) that the ROMs and the RAMs may store working schedule information and/or status information, neither of which indicates position data of the working modules relative to a fixed reference mark. Certainly then, the “store” feature of the claimed invention is not explicitly taught by, or inherently present in, the Asai ‘292 reference. The Examiner’s allegations concerning “capabilities” is not the proper test for patentability.

B. *New Independent Claim 33:*

New independent claim 33 recites the “data storage device” feature in a means plus function format to evoke treatment under 35 U.S.C. § 112 (6th). Under 35 U.S.C. § 112(6th), the means plus function element requires that the prior art element performed the identical function specified in the claims.¹⁰

¹⁰ MPEP § 2182.

Applicants respectfully submit that new claim 33 is patentable for reasons analogous to those noted above with respect to claims 10, 15 and 22.

CONCLUSION

For at least the reasons noted above, Applicants respectfully submit that claims 10, 15, and 22 are patentable, and that claims 11-14, 17, 20, 23-28, 30, and 32 are patentable at least by virtue of their dependencies.


If any matters remain at issue in the application, the Examiner is invited to contact the undersigned at (703) 668-8000 in the Northern Virginia area, for the purpose of a telephonic interview.

Pursuant to 37 C.F.R. 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a response in connection with the present application, and the required fee of \$110.00 is attached

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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